

## REMARKS

### INTRODUCTION

Claims 1-11 were previously pending and under consideration.

Claim 12 is added herein.

Therefore, claims 1-12 are now pending and under consideration.

Claims 1-11 are rejected.

Claims 1, 6, and 9 are amended herein.

No new matter is being presented, and approval and entry are respectfully requested.

### ENTRY OF AMENDMENT UNDER 37 CFR §1.116

Applicant requests entry of this Rule 116 Response because:

(a) it is believed that the amendment of the claims puts this application into condition for allowance;

(b) the amendments of the previously pending claims should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and

(c) the amendments do not significantly alter the scope of the claims and place the application at least into a better form for purposes of appeal. No new features or new issues are being raised.

The Manual of Patent Examining Procedures sets forth in Section 714.12 that "any amendment that would place the case either in condition for allowance or in better form for appeal may be entered." Moreover, Section 714.13 sets forth that "the Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

### **REJECTIONS UNDER 35 USC § 103**

In the Office Action, at pages 2-7, claims 1-2 and 5-11 were rejected under 35 U.S.C. §103 as being unpatentable over Serbinis in view of Royappa. Claims 3-4 were rejected under 35 U.S.C. §103 as being unpatentable over Serbinis in view of Royappa and further in view of Hashimoto. These rejections are traversed and reconsideration is requested.

#### **SERBINIS DOES NOT DISCLOSE HIERARCHY DEFINED BY XML BY XML INDICATING A RELATION BETWEEN DOCUMENTS IN THE HIERARCHY**

Amended independent claims 1, 6, and 9 recite a "hierarchical structure . . . defined with hypertext described in an extensible markup language", and "an XML file defining the hierarchical structure by indicating a relation between a document in the upper layer and a document in the lower layer". Serbinis does not disclose how its hierarchy of document objects, instances, and groups are defined. The purpose of Serbinis is to provide Internet-based document management services. Serbinis is not concerned with how documents may be structured together, and in fact Serbinis uses only an ordinary database as a repository of unstructured documents. At column 6, lines 25-28 of Serbinis indicate that the parent and group information of a document is stored in a database 25. However, there is no discussion of the format of the information stored in the database.

The rejection refers to, column 7, lines 16-62 of Serbinis as providing a hierarchical storage scheme for storing electronic documents. The rejection notes that there are parent and child document instances, as well as document groups. Column 16, lines 1-25 are cited as providing the XML definition.

Although Serbinis does mention using XML at column 16, XML is discussed only as a format for providing a single document in response to a request. There is no discussion or suggestion in column 16 to use XML as information for defining a hierarchical document structure or relating two documents in a hierarchy. Claims 1, 6, and 9 are amended to clarify that the previously-recited "hierarchical structure ... defined with [XML]" relates to "an XML file defining the hierarchical structure by indicating a relation between a document in the upper layer and a document in the lower layer". The added language does not narrow the claims but rather clarifies a previously recited feature. The previously recited XML-defined hierarchical structure, as a consequence of being a hierarchy, necessarily implied an XML-defined relation between

documents; this is the nature of a hierarchy. Because this feature was previously presented, it is respectfully submitted the claims are not narrowed by this amendment. For this reason, Applicant also requests withdrawal of the Final Office Action.

Applicant also notes that claim 1, for example, recites "a document database". The document database in Serbinis cannot correspond both to the document database in claim 1 *and* correspond to information for structuring a document, because the structuring information and the document database in claim 1 are recited as different and distinct features.

Royappa was not cited for and does not disclose or suggest the features discussed above.

Withdrawal of the rejection of claims 1, 6, and 9 is respectfully requested.

#### SERBINIS DOES NOT DISCLOSE RETRIEVING TOGETHER A DOCUMENT IN AN UPPER LAYER AND A DOCUMENT IN A LOWER LAYER

Amended claims 1, 6, and 9 recite "a client ... retrieves together, based on the management information [which defines the hierarchical structure], both the document in the upper layer and the document in the lower layer". This feature is supported at least by Figure 20 steps SO13 to SO15, which relate to multiple slave documents (e.g. drawings) being retrieved based on a request to retrieve a corresponding master document.

Serbinis discusses only retrieving a single document at one time. Therefore it is not possible that two documents that are hierarchically related (i.e. from structurally related upper and lower layers) are both retrieved by a client at one time. A case in Serbinis where a client first requests and retrieves one document and at some later time requests and retrieves another document is distinguishable, because such documents would not be retrieved together.

Royappa was not cited for and does not disclose or suggest the features discussed above.

Withdrawal of the rejection of claims 1, 6, and 9 is further respectfully requested.

**PRIMA FACIE CASE NOT MADE; MOTIVE NOT FOUND IN PRIOR ART**

In order to establish a prima facie case of obviousness, the Examiner must provide a motive in the prior art. The motive must be one showing the desirability of making the proposed modification or addition. The §103 obviousness rejection states that one would be motivated to add Royappa to Serbinis "because it would have provided [Serbinis with] the capability for describing information of an XML document and for defining a style of an XML document". However, this motive is not provided from the prior art and is given without any citation to a prior art reference. No prior art is cited to provide a required notice or indication of why one skilled in the art would find it desirable to define a style with an XML document.

MPEP §2143.01 states that "an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support", and therefore does not satisfy a prima facie case of obviousness.

Withdrawal of the obviousness rejection is respectfully requested.

**DEPENDENT CLAIMS**

The dependent claims are deemed patentable due at least to their dependence from allowable independent claims. These claims are also patentable due to their recitation of independently distinguishing features. For example, claim 3 recites "a document registered in the document database is updated, the updated document in the document database, and also updates the version number information in the management information related to the document". This feature is not taught or suggested by the prior art. Withdrawal of the rejection of the dependent claims is respectfully requested.

**NEW CLAIM**

New claim 12 has been added to clarify a broader aspect of the present invention and to provide alternative claim language.

**CONCLUSION**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

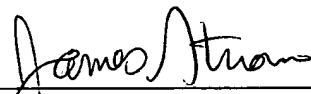
Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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